

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/235,153 01/22/99 GEORGES

F SB-B750

HM22/0223

EXAMINER

LORUSSO & LOUD  
3137 MOUNT VERNON AVENUE  
ALEXANDRIA VA 22305

EINSMANN, J

ART UNIT	PAPER NUMBER
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1655

*8*

DATE MAILED:

02/23/01

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/235,153	GEORGES ET AL.
	Examiner Juliet C. Einsmann	Art Unit 1655

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-33 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claims 1-33 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

15) <input type="checkbox"/> Notice of References Cited (PTO-892)	18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ .
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .	20) <input type="checkbox"/> Other: _____ .

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-10, 15-16, 18, and 27-33, drawn to methods for making plants genetically transformed with a choline metabolizing enzyme, classified in class 800, subclass 278.
  - II. Claims 1-8, 11 and 27-33, drawn to methods for making plants genetically transformed with ferulic acid decarboxylase, classified in class 800, subclass 278
  - III. Claims 1-8, 12-20, and 27-33, drawn to methods for making plants genetically transformed with an enzyme which acts on a sugar alcohol, classified in class 800, subclass 278.
  - IV. Claims 21 and 26, drawn to vectors comprising the COX gene, classified in class 435, subclass 320.1.
  - V. Claims 22 and 26, drawn to vectors comprising a BADH gene, classified in class 435, subclass 320.1.
  - VI. Claims 23 and 26, drawn to vectors comprising a ferulic acid decarboxylase gene, classified in class 435, subclass 320.1.
  - VII. Claims 24-26, drawn to vectors comprising an IMT gene, classified in class 435, subclass 320.1.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II, I and III, and II and III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

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modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01).

In the instant case the different inventions are drawn to methods for transforming plants with different genes. These methods are patentably distinct in so far as the methods for transforming plants with each of the distinct genes would confer different results and properties on the resultant plant. It is noted that each of these groups contains common linking claims (1-8, 15-16, and 27-33), and these broad claims will be examined with whichever group is selected.

3. Inventions I and IV, I and V, II and VI, and III and VII are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the vectors of inventions IV, V, VI and VII can be used in other method such as to expression of the gene of interest in a simple host cell, as well as for nucleic acid hybridization methods and nucleic acid purification methods.

4. Inventions I and VI, I and VII, II and IV, II and V, II and VII, III and IV, III and V, and III and VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are unrelated because the products of inventions IV, V, VI, and VII are not required for or useful in the respective methods as listed above.

5. Inventions IV and V, IV and VI, IV and VII, V and VI, V and VII and VI and VII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects

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(MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are all products which comprise vectors comprising different genes. The genes themselves are structurally and chemically different, as would be evidenced by their different sequences and the fact that they encode different, unrelated chemical products.

6. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as demonstrated by their different classification and recognized divergent subject matter and because inventions I-VII require different searches that are not coextensive, examination of these claims would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

7. A telephone call was made to George Loud on 2/6/01 to request an oral election to the above restriction requirement, but did not result in an election being made.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliet C. Einsmann whose telephone number is (703) 306-5824. The examiner can normally be reached on Monday through Thursday, 7:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W. Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-4242 and (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

*dc*  
Juliet C. Einsmann  
Examiner  
Art Unit 1655

February 21, 2001.

*W. Gary Jones*  
W. Gary Jones  
Supervisory Patent Examiner  
Technology Center 1600